

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

REMARKS

This is in reply to the Office Action¹ dated January 30, 2006. Claims 1-25 were previously elected for examination and prosecution in response to the restriction requirement in the Office Action dated January 26, 2005. Claims 1-25 are rejected in the instant Office Action. No claims are added, canceled or amended hereby. Therefore claims 1-25 are pending.

Claims 1-16, 19-21 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugauchi et al., U.S. Patent No. 6,339,789 B1 (hereinafter "Sugauchi"), in view of Roytman et al., U.S. Patent Application No. 2002/0012011 A1. Claims 17-18 and 22 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugauchi-Roytman in view of Branton, Jr. et al., U.S. Patent No. 6,301,336 (hereinafter "Branton"). Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugauchi-Roytman-Branton further in view of U.S. Patent No. 6,343,290 to Cossins et al., (hereinafter "Cossins"). Therefore all claims are rejected as being unpatentable over Sugauchi-Roytman, either taken alone or in combination with Branton, or Branton and Cossins. Applicants respectfully traverse these rejections for the following reasons.

¹ The Office Action may contain a number of statements characterizing the cited reference(s) and/or the claims which Applicant(s) may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant(s) does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant(s) deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant(s) that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

In accordance with MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. And, all three of these basic criteria must be met - if any one is not met the *prima facie* case of obviousness is not made.

In this instance, not only is there is no discernable suggestion or motivation in either Sugauchi or Roytman to combine its teachings with the other, the references actually teach away from any attempt at their being combined. Sugauchi, for example, at least in Fig. 23 and in column 20, lines 11-22, discusses enlargement of event information to be displayed. Any enlargement of information on the event display screen concomitantly reduces display screen availability for display of other information. Therefore, any alleged separate list of recent events conjured-up from Roytman that allegedly could be added to the event display screen of Sugauchi would be in competition for available GUI display screen space. The notion of enlargement of any or all of the event information to be displayed on the display screen in Sugauchi is in direct conflict with the notion of importing yet additional recent event information for display on Sugauchi's display screen from some unrelated source (e.g., from Roytman).

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

This conflict is highlighted further when one considers Sugauchi, column 20, lines 2-5: "To enable displaying of the various event information, in the second embodiment, enlargement processing for gradually enlarging event information to be displayed according to the instruction of a user is further executed." (Emphasis added.) In other words, the user can gradually (i.e., continuously or step-wise) enlarge the event information which implies that the enlarging is made under user control to the user's satisfaction. Thus, if the user wants or needs to make particular event information quite enlarged to be able to view certain details of that particular event information to enable the user to handle a network problem characterized by that particular event information, then the user can expand the display to that quite enlarged extent. This is completely incompatible with crowding-out that enlargement with another event list on the display screen. Therefore, Sugauchi teaches away from its being combined with any other reference, including Roytman, for purposes of adding a second list of events occurring in the network to the graphical user interface. A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985).

Roytman fails in this regard as well. In paragraph [0049], it says: "When the alarm log has many records, the large number of rows will not fit on the screen display 700. Consequently, the scroll bar 704 is provided to allow a user to scroll the records up and down on the screen so that a desired record can be brought into view." (Emphasis added.) In other words, Roytman's screen of "new events" information can be so

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

completely filled that it needs to implement a scrolling function in order for a user to see all of the records. This does not suggest to someone skilled in the art, reading Roytman, to take this "new event" information which is overflowing on the Roytman terminal screen, and add it to yet other information on another (e.g., Sugauchi) terminal screen. If there is no room for all of the information in Roytman to be viewed on Roytman's terminal screen simultaneously, then that shortcoming certainly does not suggest crowding-out that information even further by combining it on a terminal screen with other information that is being displayed by Sugauchi. Therefore, Roytman also teaches away from its being combined with any other reference including Sugauchi for purposes of adding a second list of events occurring in the network to a graphical user interface. As noted, a reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention.

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985).

Moreover, in view of the above analysis, there is no reasonable expectation of success in making the alleged combination between Sugauchi and Roytman. Any hypothetical additional list that is usurping display-room from the Sugauchi screen inhibits, if not outright prevents, any enlargement of event information which is a central feature of Sugauchi. Thus, there is no reasonable expectation of success in attempting to make this alleged combination of references.

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

Applicants respectfully submit that the Examiner, in this particular instance, is using Applicants' claims as a blueprint for hindsight-combining of patent references. In other words, it is Applicants' opinion that after the Examiner has read "simultaneously providing a second list of events occurring in the network to the graphical user interface, the second list comprising a predetermined number of most recent events" as recited in claim 1, the Examiner then constructed a reference combination to allegedly meet that claim limitation without first finding motivation in those references to make that combination. It is established law that one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecocolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

All claims, claims 1-25, are rejected on the basis of the combination of Sugauchi and Roytman, either alone or in further combination with Branton and/or Cossins. Therefore, in view of the above analysis where Sugauchi and Roytman have been shown to be un-combinable, and where there is no reasonable likelihood of success in attempting

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

to make the Sugauchi/Roytman combination, Applicants submit that a *prima facie* case of obviousness has not be established with respect to any pending claim. Accordingly, the 35 U.S.C § 103(a) rejection of all claims should be withdrawn and the claims allowed.

PATENT
U.S. Patent Application Serial No. 09/702,303
Attorney Docket No. 00-8008

CONCLUSION

Reconsideration and allowance are respectfully requested for reasons given above. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account 07-2347.

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